

Attorney Docket No: 23546-07665
Client Ref: RTS-274
USSN: 10/006,191

REMARKS

STATUS OF THE CLAIMS

Claims 1-14 were pending in this application. Claims 15-20 have been previously withdrawn. Claims 1 and 3 have been amended, and claim 11 has been canceled. Following entry of the amendments claims 1-10 and 12-14 will be pending and at issue.

SUPPORT FOR AMENDMENTS TO THE CLAIMS

Claim 1 has been amended to recite compounds "targeted to nucleobases 2212 through 2238 of a nucleic acid molecule encoding connective tissue growth factor (SEQ ID NO:19)." Nucleobases 2212 through 2238 of SEQ ID NO:19 is the target site of antisense compounds comprising overlapping SEQ ID NOS: 47, 48, 63 and 64. Support for this amendment can be found throughout the specification as filed, e.g., Table 1 on pages 92-93.

Claim 3 has been amended merely to delete non-elected subject matter.

The amendments to the claims therefore add no new matter and entry is requested.

ALLOWABLE SUBJECT MATTER

Claim 3 was objected to; the Examiner stated that "Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and deleting nonelected subject matter." The Examiner also stated that "Applicant's election without traverse of Group I and SEQ ID NO: 48 in Papers filed 3/04/04 is acknowledged. It is noted that upon examination and search of SEQ ID NO:48, it became apparent that the search of SEQ ID NOS: 47, 63, and 64 would not be a burden in addition to SEQ ID NO: 48. SEQ ID NOS: 47, 48, 63 and 64 have been examined."

In response, Applicant has amended claim 1 so that it recites a target of nucleobases 2212 through 2238. Applicant notes that SEQ ID NOS: 47, 48, 63, and 64 hybridize to overlapping targets of SEQ ID NO:19, e.g., nucleobases 2212 through 2238. Applicant has also amended claim 3, deleting nonelected subject matter. Applicant believes these amendments place the claims in condition for allowance.

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IDS

Applicant notes with appreciation the Examiner's thorough consideration of the references cited in the IDS (Form 1449) submitted on December 10, 2001.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1 and 2 were rejected under 35 U.S.C. 102(a) as allegedly anticipated by Dunn et al (Accession No. AZ781130 an Database rst.seq, 16 February 2001). Dunn et al disclose a 25mer oligonucleotide corresponds to nucleotides 1793-1817 of SEQ ID NO: 19 with a single base mismatch. Claims 1 and 2 were also rejected under 35 U.S.C. 102(b) as allegedly anticipated by Hillier et al [Accession No. R06912 on Database rst.seq, 05 April 1995]. Hillier et al disclose an oligonucleotide that corresponds to nucleotides 2008-2044 of SEQ ID NO: 19.

Without agreeing with the Examiner's position but rather to further prosecution, Applicant has amended claim 1 to recite a target of nucleobases 2212 through 2238 of SEQ ID NO:19. Neither Dunn nor Hillier disclose a sequence that corresponds to or is complementary to the recited target of claim 1 as amended herein, nor does either prior art reference disclose a compound that hybridizes to and inhibits the expression of connective tissue growth factor. Accordingly neither cited reference anticipates the claims as amended and withdrawal of this rejection is respectfully requested.

Claim 11 was rejected under 35 U.S.C. 102(b) as allegedly anticipated by Schmidt et al [US 6,358,741]; under 35 U.S.C. 102(b) as allegedly anticipated by Hishikawa et al [European Journal of Pharmacology]; under 35 U.S.C. 102(b) as allegedly anticipated by Shimo et al [cited by applicant]; under 35 U.S.C. 102(b) as allegedly anticipated by Hishikawa et al [The Journal of Biological Chem., cited by applicant].

Without agreeing with the Examiner's position but rather to further prosecution, Applicant has cancelled without prejudice claim 11, rendering the pending rejections moot. Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

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REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 2, 4-10 and 12-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al [US 6,358,741], Hishikawa et al [European Journal of Pharmacology, cited by applicant], Kubota et al [cited by applicant], EI-Din et al [cited by applicant], Shimo et al [cited by applicant], Hishikawa et al [The Journal of Biological Chem., cited by applicant], Baracchini et al [US 5,801,154], and Bennett et al. [US 5,998,148].

Three requirements must be met for a prima facie case of obviousness. First, the prior art references must teach all the limitations of the claims. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. Third, a reasonable expectation of success is required.

Claim 1 as amended herein recites a compound targeted to nucleobases 2212 through 2238 of SEQ ID NO:19. Dependent claims 2, 4-10, and 12-14 ultimately depend on claim 1 and therefore include all elements of claim 1. The cited prior art references do not teach all of the elements of the claims. Specifically, the combination does not include the element of a target of nucleobases 2212 through 2238 of SEQ ID NO:19. The combination cannot render the claims obvious, and withdrawal of this rejection is respectfully requested.

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CONCLUSION

Reconsideration of the claims is respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (415) 875-2316.

Respectfully submitted,
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